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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/625,249 07/25/00 BERLOWITZ

P JNP-0007

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EXAMINER

MEDLEY, M

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/625,249

Applicant(s)

BERLOWITZ et al

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 7-13-01

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-7

Of the above claim(s) _____ is/are pending in the application.

☐ Claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

_____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 for reasons made of record in Paper No. 3 dated March 5, 2001 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,180,842 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons made of record in Paper No. 3 dated March 5, 2001.

Claims 1-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,689,031. Although

the conflicting claims are not identical, they are not patentably distinct from each other because of reasons made of records in Paper No. 3 dated March 5, 2001.

Claims 1-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,766,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons made of record in Paper No. 3 dated March 5, 2001.

Claims 1-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,807,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reason made of record in Paper No. 3 dated March 5, 2001.

Keep Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,274,029. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons made of record in Paper No 3 dated March 5, 2001.

Keep Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4 and 5-19 of copending Application No. 08/971,254. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons made of record in Paper No. 3 dated March 5, 2001.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed July 13, 2001 and Berlowitz Rule 132 Declaration dated July 13, 2001 have been fully considered but they are not persuasive.

The data presented in the Berlowitz Rule 132 Declaration have been reconsidered but are not deemed to show conclusive unexpected results. For instance it is unclear what is meant by product AGC-21 in Application No. 09/138,130, which was not explicitly found in said application by the examiner. It is unclear to the examiner what is meant by "high sulfur virgin distillate" and "low sulfur virgin distillate" found in Application No. 09/138,130 because the terms "high" and "low" are relative terms.

Applicants argue that the relative proportion for the two components is not indefinite. The examiner disagrees with said argument in that the blend consist of the mixing of two distinct components in relative proportions to each other. The examiner maintains the position stated of record that the claims are indefinite for failing to give the chemical characteristics of the two distinct components because the F-T component, e.g. depending on the initial boiling point range, will determine whether it is a diesel fuel component or some other lighter fuel component.

In response to applicant's argument that the unhydrotreated F-T product blended with a hydrotreated F-T of U.S. 5,689,031 is different from the instant claims, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants have not distinguished the instant claimed F-T products from the F-T products of Patentee. The (b) virgin distillate of Applicant is not excluded from the distillate fraction of Patentee because their claims contained the open-ended language containing.

In response to applicant's argument that the unhydrotreated F-T product blended with the hydrotreated F-T product of U.S. 5,766,274 is different from the instant claims, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants have not distinguished their F-T products from that of Patentee. The (b) virgin distillate of Applicants is not excluded from the claims of Patentee which material are useful as a jet fuel or as a blending component for a jet fuel.

In response to applicant's argument that the unhydrotreated F-T product blended with a hydrotreated F-T material is different from the instance claims, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants have not distinguished their F-T products from the products of Patentees because the blended material overlap each other and therefore are not patentable distinct.

In response to applicant's argument that the unhydrotreated F-T product blended with a hydrotreated F-T of US application 08/971,254 is different from the instant claims, the fact that

applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants have not distinguished their blended materials from those of related application 08/971,254.

In response to applicant's argument that the two blended F-T products prior to hydrotreating is a better product for volatility US 5,807,413, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants have not distinguished their blended F-T product from that of Patentee. The (b) virgin distillate of Applicants is not excluded from the materials of Patentees because their claims contains the open-ended language "comprising".

In response to applicant's argument that the blending of greater than 40% virgin distillate with a F-T product still improves the stability of the blended product for more than the expected linear improvement and beyond that claimed in US 6,180,842B1, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants have not distinguished their F-T fractions and virgin distillates from the fuel products of Patentees. The Rule 132 Declaration does not show conclusive unexpected results for reasons set forth super.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MMedley:evh

10/01/01


MARGARET MEDLEY
PRIMARY EXAMINER